



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,525	10/11/2005	Katsu Kondo	KPO-SUN-P4/SN-89/US	4420
44702	7590	10/04/2010	EXAMINER	
OSTRAGER CHONG FLAHERTY & BROITMAN PC 570 LEXINGTON AVENUE FLOOR 17 NEW YORK, NY 10022-6894			STULII, VERA	
			ART UNIT	PAPER NUMBER
			1781	
			NOTIFICATION DATE	DELIVERY MODE
			10/04/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jbroitman@ocfblaw.com
lmurrell@ocfblaw.com
dflaherty@ocfblaw.com



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

wk

Mailed:

OCT 04 2010

In re application of :
Kondo : DECISION ON
Serial No. 10/552,525 : PETITION
Filed: October 11, 2005 :
For: PROCESS FOR PRODUCING FOOD OR DRINK
FROM MALT ROOT

This is a decision on the PETITION FILED UNDER 37 CFR 1.181 on August 16, 2010 to withdraw the final status of the Office Action dated February 22, 2010. The Examiner issued an Advisory on August 8; 2010.

In response to the Final Office Action filed July 21, 2010, Applicants presented arguments that were directed to the English language abstract of the Todorova et al. reference, since only a translation of the abstract was provided to Applicants. The Examiner issued an Advisory Action mailed August 10, 2010 that made it clear the Examiner relied on the entire Todorova et al. reference, written in Bulgarian and not just the English language Abstract.

The Examiner indicated to Applicants that a full translation would be requested and that the final rejection would be withdrawn once the translation was received. Applicant was advised by the Examiner to file a Notice of Appeal or Request for Continued Examination (RCE) in order to keep the case pending.

When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying document is generally inappropriate where both the abstract and the underlying document are prior art. See Ex parte Jones, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished).

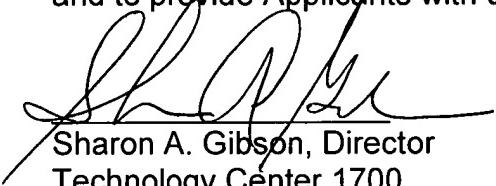
To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the Examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection. The record must also be clear as to whether the Examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection. An abstract can have a different effective publication date

than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection.

DECISION

The petition for withdrawal of finality is **GRANTED**.

The Examiner is directed to issue an office action based on the full Todorova et al. reference and to provide Applicants with a full translation.



Sharon A. Gibson, Director
Technology Center 1700
Chemical and Materials Engineering

Manette Dennis
OSTRAGER CHONG FLAHERTY & BROITMAN PC
570 LEXINGTON AVENUE
FLOOR 17
NEW YORK NY 10022-6894